



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,824	08/08/2001	Dong-Mei Feng	20183YCA	7413

210 7590 04/28/2003

MERCK AND CO INC  
P O BOX 2000  
RAHWAY, NJ 070650907

EXAMINER

CHISM, BILLY D

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 04/28/2003

S

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/924,824

Applicant(s)

FENG, DONG-MEI

Examiner

B. Dell Chism

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to a conjugate of Formula I, classified in class 424, subclass 191.3+.
  - II. Claims 14-17, drawn to a method of treating prostate cancer comprising administering a conjugate of Formula I, classified in class 514, subclass 556+.
  - III. Claim 19, drawn to a method of making a pharmaceutical composition comprising a conjugate of Formula I, classified in class 424, subclass 191.3+.
  - IV. Claims 20-23, drawn to a compound of Formula II, classified in class 424, subclass 191.3+.
  - V. Claims 24-25, drawn to a method of treating prostate cancer comprising administering a compound of Formula II, classified in class 514, subclass 556+.
2. The inventions are distinct, each from the other because:

Groups I and II-III are distinct inventions as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the processes (Groups II-III) for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be use in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins of Group I can be used for immunoassays, molecular weight markers and antibody production.

Art Unit: 1654

Groups I and IV are independent as different products having different structures, functions and bioactivity.

Groups I and V are independent wherein the product of Group I can neither be made by nor used in the methods of Group V.

Groups II and III and V are independent as methods groups having different purposes and results and requiring different products.

Groups II and IV are independent wherein the product of Group IV can neither be made by nor used in the methods of Group II.

Groups III and IV are independent wherein the product of Group IV is neither made by nor used in the method steps of Group III.

Groups IV and V are distinct inventions as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the processes (Groups II-III) for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be use in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins of Group IV can be used for immunoassays, molecular weight markers and antibody production.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search for the patentably distinct groups would not be coextensive, restriction for examination purposes as indicated is proper.

4. Claims 1-25 are generic to a plurality of disclosed patentably distinct compounds comprising compounds of general Formula I and compounds of general Formula II. Applicant is

Art Unit: 1654

required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Regardless of which Group (I-V) applicants elects, applicants are further required under 35 U.S.C. §121 to elect a single disclosed species of the conjugate for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The elected species should be a specific compound or conjugate wherein all of the substituent variables are accounted for, including a clear expanded structure for the same.

Should applicant traverse on the ground that the compounds are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the compounds to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Dell Chism whose telephone number is 703-306-5815. The examiner can normally be reached on 7:30 AM - 4:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 703-306-3220. The fax phone numbers for the

Application/Control Number: 09/924,824

Page 5

Art Unit: 1654

organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

\*\*\*

B. Dell Chism

24 April 2003

*Brenda Brumback*  
BRENDA BRUMBACK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600